

Remarks/Arguments:

Claims 1, 2, 4-8 and 11-16 are pending in the above-identified application. Claim 3 is cancelled. Claims 9, 10, 17 and 18 are withdrawn from consideration. Claims 7, 8, 12 and 13 are allowed.

Claims 1 and 11 were rejected under 35 U.S.C. § 102 as being anticipated by Chen et al. With regard to Claim 1, the ground for rejection is respectfully traversed. The Office Action recites, "Chen further teaches the prior art run-length decoding the DV stream but that the system of Chen does not run-length decode or encode.. Therefore the run-length data must be contained in the DCT." Applicants respectfully disagree with this analysis as it pertains to the subject application. The cited passage in the specification states: "it is worthy to note that although in the embodiments of the invention transformer 217 is implemented without run-length decoding or encoding, these functions can be incorporated into DV decoder 218 and MPEG encoder 220." (See col. 7, lines 15-17). This statement has been misinterpreted in the Office Action. The ordinarily skilled person, upon reading this statement, would understand that, in the examples described by Chen et al. none of the coefficients were run-length encoded and, thus, that there was no need to run-length decode the coefficients. If the coefficients had been run-length encoded, however, is passage states that they would need to be run-length decoded. This passage does not disclose or suggest a transcoder that can accept and transcode run-length encoded values without run-length decoding these values, as required by claims 1 and 11.

In both the subject application and Chen, the bit stream includes consecutive coefficients. Chen requires that these coefficients be put into an 8x8 matrix. (See col. 8, lines 45-60). If these coefficients were run-length encoded values, one of the run-length encoded values would represent more than one coefficient value. If these values were loaded into an 8X8 matrix without run-length decoding, as required by Chen et al., that matrix would include coefficient values from more than one block. Moreover, these coefficients would not be in the proper position for correct operation of the invention. Thus, it would be apparent to the ordinarily skilled person that, if the received values were run-length encoded, they would need to be run-length decoded before the process described by Chen et al. could be applied.

With regard to claim 11, the ground for rejection is traversed for the same reasons as stated above with regard to claim 1.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. in view of Potu. Potu concerns a method for decoding data that has been encoded in a variable length code word. It does not concern transcoding the data, only decoding. Thus, Potu can not disclose or suggest:

decoding the first encoded video signal to obtain a stream of DCT coefficient blocks in the first format wherein at least some of the DCT coefficient blocks include run-length coded coefficient values;

reformatting the DCT coefficient blocks obtained from the first encoded video signal into DCT coefficient blocks for the second format without run-length decoding the run-length coded values

as required by claim 1 of the subject application.

Claim 2 includes all the features of claim 1 from which it depends. Therefore, Claim 2 is not subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. in view of Potu.

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. and Potu in further view of Linzer et al. Linzer et al. concerns a compressed video transcoder. Linzer et al. describe a transcoder that fully decodes one encoded signal to reproduce a sequence of decoded video frames and then re-encodes the frames using the other encoding method. (See col. 2, lines 50-52 and 63-65). Thus, Linzer et al. can not describe a transcoder that reformats run-length encoded DCT coefficients without run-length decoding the run-length encoded values, as required by claim 1 of the subject invention. Claim 4 has been amended to be independent in form, including all of the limitations of claim 1. Accordingly, the rejection of claim 4 is overcome by the amendment to claim 4 for the same reasons as stated above with regard to claim 1.

The rejection is also overcome, independent of the same reasons as stated above with regard to claim 1, because neither of the references disclose or suggest setting the MPEG quantization matrix to correspond to a finest quantization step size in the DV quantization table. Neither Chen nor Linzer describe how quantization is performed. Potu fully dequantizes the coefficients. (col. 6, lines 63-67). The subject application partially dequantizes. Instead of giving the quantization step size for each coefficient, the DCT coefficients are reformatted by setting the MPEG quantization matrix to correspond to a finest quantization step size in the DV quantization table. (pg. 4, lines 17-27).

Claim 5 includes all the features of claim 4 from which it depends. Therefore, Claim 5 is not subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. and Potu in further view of Linzer et al.

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. in view of Tsuboi et al. Tsuboi et al. concerns a digital video recorder that sets a number of compression blocks according to its operational mode. In Tsuboi et al. the different modes refer to different resolutions and, thus, different amounts of data that are to be compressed. With regard to Claim 14, the ground for rejection is respectfully traversed. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (emphasis added)*¹ The only suggestion to combine the references comes from Applicant's disclosure. The Examiner is impermissibly using Applicant's disclosure to support the combination Chen et al. and Tsuboi et al.

Even if the combination of Chen et al. and Tsuboi et al. were appropriate, however, it would still not be obvious to combine the transcoder of Chen et al. with the method of Tsuboi et al. because neither reference suggests or discloses, "...selectively setting to zero one of a) the coefficients in the plurality of lists of overflow macroblock coefficients and b) coefficients in the list of overflow segment coefficients to control a data rate of the second signal..." Therefore, Claim 14 is not subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. in view of Tsuboi et al.

Claims 15 and 16 include all the features of claim 14 from which they depend. Therefore, Claims 15 and 16 is not subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. in view of Tsuboi.

Applicants appreciate the indication in the Office Action that claims 7, 8, 12 and 13 are allowed, and that claim 6 would be allowed if rewritten to be independent in form and to include

¹ MPEP §706.02(j)

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the limitations of its base claim and any intervening claims. Claim 6 depends from claim 1, which, as set forth above, is not subject to rejection. Thus, claim 6 is not subject to rejection for at least the same reasons as claim 1.

In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the rejection of claims 1, 2, 4-5, 11 and 14-16 and the objection to claim 6.

Respectfully submitted,



Kenneth N. Nigon, Reg. No. 31,549
Attorney for Applicants

KNN/nmc

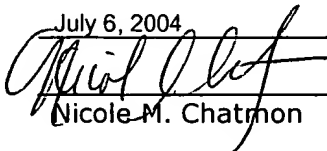
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P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

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Nicole M. Chatmon